



Attorney Docket No. 13971US04

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Appellants:

Grooms, *et al.*

Serial No.: 09/905,683

Filed: July 16, 2001

For: "Multi-Component Cortical
Bone Assembled Implant"
(As Amended)

Group Art Unit: 3738

Examiner: Bruce Edward Snow

EXPRESS MAIL No.: EV 726847747 US

DATE: JUNE 11, 2007

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir,

In response to the Notification of Non-Compliant Appeal Brief that was mailed in May 11, 2007, the Appellants hereby submit an amended Section III, providing the claims on appeal. This submission is believed to be timely as it is being sent via Express mail within the one month period for response as set forth in the Notification of Non-Compliant Brief, ending on June 11, 2007.

Remarks begin on page 2 of this submission.



6-12-7

AF
JW

PTO/SB/21 (07-06)

Approved for use through 09/30/2006

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	09/905,683
		Filing Date	July 16, 2001
		First Named Inventor	Jamie M. Grooms
		Art Unit	3738
		Examiner Name	Bruce Snow
		Attorney Docket Number	13971US04
Total Number of Pages in This Submission		6	
ENCLOSURES (check all that apply)			
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	
Remarks		<input type="checkbox"/> After Allowance Communication to TC <input checked="" type="checkbox"/> Response to Notification of Non-Compliant Appeal Brief <input checked="" type="checkbox"/> Return-Receipt Postcard <input type="checkbox"/> Other Enclosure(s) (please identify below):	
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual Name	McAndrews Held & Malloy, Ltd.		
Name (Print/type)	Jennifer E. Lacroix, Esq.	Registration No. (Attorney/Agent)	46,852
Signature			Date: June 11, 2007
EXPRESS MAIL DEPOSIT			
"Express Mail" mailing label number : EV 726847747 US Date of Deposit June 11, 2007			

Remarks

The Notification of Non-Compliant Appeal Brief indicated that the Brief on Appeal as originally submitted did not state which claims are on appeal. An amended Section III is provided below, which states that claims 111-118 and 120-136 as currently pending are presented for consideration on appeal:

III. STATUS OF THE CLAIMS

The present application was filed on July 13, 2001 with claims numbered 1-58.¹ A Notice to File Missing Parts of Nonprovisional Application was mailed on December 10, 2001,² to which a Response was filed on March 11, 2002.³ A Preliminary Amendment was filed that was received by the Office of Initial Patent Examination on January 30, 2002, in which claims 1-58 were canceled and claims 59-110 were added.⁴ A restriction requirement under 35 U.S.C. §121 was mailed on August 6, 2003.⁵ A Response to the restriction requirement was filed on September 11, 2003,⁶ and an Office Communication stating that the Response was not fully responsive to the restriction requirement was mailed on October 8, 2003.⁷ In response, on February 16, 2004, Appellants elected the species of the embodiment of Figure 7, canceled claims 59-110, and added claims 111-128.⁸ Claim 119 was withdrawn from consideration as being drawn to non-

¹ Exhibit 1, Evidence Appendix.

² Exhibit 2, Evidence Appendix.

³ Exhibit 3, Evidence Appendix

⁴ Exhibit 4, Evidence Appendix

⁵ Exhibit 5, Evidence Appendix.

⁶ Exhibit 6, Evidence Appendix

⁷ Exhibit 7, Evidence Appendix

⁸ Exhibit 8, Evidence Appendix

elected inventions or species in the Office Action mailed on March 16, 2004.⁹ Additionally, in the Office Action mailed on March 16, 2004, claims 111-118 and 120-128 received a provisional double patenting rejection, and were rejected under 35 U.S.C. §103(a).¹⁰

In an Amendment and Response dated September 16, 2004, claims 111-113 were amended.¹¹ In a non-final Office Action mailed December 15, 2004, the provisional double patenting rejection was maintained, claim 117 was rejected under 35 U.S.C. §112, second paragraph, claims 111-118, 120-123 and 126-127 were rejected under 35 U.S.C. §102(b), and claims 111-118 and 120-128 were rejected under 35 U.S.C. §103(a).¹²

In an Amendment and Response dated April 13, 2005, claims 111 and 117 were amended.¹³ A final Office Action was then mailed on June 17, 2005, in which the provisional double patenting rejection was maintained, claims 111-118, 120-123 were rejected under 35 U.S.C. §102(b), and claims 111-118 and 120-128 were rejected under 35 U.S.C. §103(a).¹⁴

A Request for Continued Examination was filed together with an Amendment and Response on December 19, 2005.¹⁵ In the Amendment and Response filed with the Request for Continued Examination, claim 111 was amended and claims 129-136 were added by copying the previously

⁹ Exhibit 9, at p. 2, Evidence Appendix.

¹⁰ Id. at pp.2-4.

¹¹ Exhibit 10, at p. 9, Evidence Appendix.

¹² Exhibit 11, at pp. 2-7, Evidence Appendix.

¹³ Exhibit 12, at pp. 2-3, Evidence Appendix.

¹⁴ Exhibit 13, at pp. 3-8, Evidence Appendix.

¹⁵ Exhibit 14, Evidence Appendix.

presented claims 111-118 and amending the independent claim.¹⁶ Claims 129-136 thus constituted an amended form of previously rejected claims 111-118.

A Non-Final rejection was mailed on March 15, 2006, in which the provisional double patenting rejection was withdrawn, claims 111-118, 120-123 and 129-136 were rejected under 35 U.S.C. §102(b), and claims 111-118 and 120-136 were rejected under 35 U.S.C. §103(a).¹⁷ In accordance with 35 U.S.C. §134, each of the pending claims having been twice rejected, a Notice of Appeal was then filed on September 11, 2006.¹⁸....

In the present application, claims 111-118 and 120-136 are pending and have been twice rejected. All presented amendments to these claims have been entered. Claims 111-118 and 120-136 as currently pending are presented for consideration on appeal. The text of pending claims 111-118 and 120-136 is attached in the Claims Appendix filed herewith.

Appellants believe that the deficiencies noted in the Notification of Non-Compliant Appeal Brief have been corrected, and respectfully submit that the amended Section III provided herewith places the Appeal Brief in Compliance.

¹⁶ Id. at pp.2-5, and 6.

¹⁷ Exhibit 15, at pp. 2 and 6-10, Evidence Appendix.

¹⁸ Exhibit 16, Evidence Appendix.

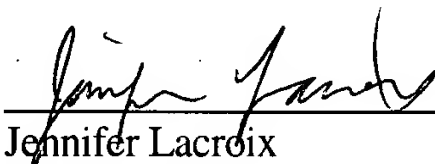
Conclusion

Applicants believe that no fee is currently due with this Response to Notification of Non-Compliant Appeal Brief. The Commissioner is, however, hereby authorized to charge any necessary fees, or credit any overpayment, to Deposit Account 13-0017 in the name of McAndrews, Held & Malloy, Ltd.

Dated: June 11, 2007

Respectfully submitted,

By:



Jennifer Lacroix
Registration No. 46,852
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000